

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars:

1. Amendments and Support for Same

By the Response, claims 1 and 9 have been amended to improve the clarity of the claim language. No new matter has been added. Accordingly, claims 1-9 are respectfully submitted for consideration.

With respect to the Examiner's contention that claims 1-3 and 8 recite "by means of solder flow", and that such a recitation is a process limitation in a product claim in accordance with MPEP §2113 and §2173.05(p), Applicant has amended claim 1 to delete "means of". Further, Applicant respectfully submit that the pending claims are device claims and not a product by process as alleged by the Examiner, and that the claims are compliant with at least MPEP §2173.05(g) and case laws, as set forth below.

With respect to claim 2-3 and 8, the claims do not recite any "means of" as alleged by the Examiner.

Further, Applicant respectfully submits that there is nothing intrinsically wrong in defining something by what it does rather than what it is. MPEP §2173.05(g) and *In re Hallman* (CCPA 1981) 655 F.2d 212, 210 USPQ 609. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004). Hence, by the use of structural limitations as well as functional descriptions, Applicant's claims are in compliance with at least the guidelines set forth in MPEP §2173.05(g).

Approval and entry of the amendments are respectfully requested.

2. Rejection under 35 U.S.C. §102(e)

With respect to the rejection of claims 1 and 9/1 under 35 U.S.C. §102(e) as being anticipated by Maeda (US 6,590,991), Applicant respectfully traverses the rejection at least for the reason that Maeda fails describe each and every limitation recited in the rejected claims.

In page 3 of the Office Action, the Examiner contends that “reheating or dissolving adhesive from annular clearance 12d allow the housing to be detached from the bracket.” In response, Applicant respectfully submits that Maeda does not support or suggest the idea of making the housing to be detachable from the bracket, and that the Examiner’s contention actually is contrary to the original function and structure described in Maeda.

Applicant respectfully directs the Examiner’s attention to Maeda, which states:

“An outer peripheral end face 12a of the flange 12i is fitted in an inner periphery 10c of the main body case 10 in pressing contact therewith and adhered thereto, whereby the bottom plate 12 is secured to the main body case 10.

Consequently, the bottom plate 12, even if having a small thickness, can be secured to the main body case 10 with the highest possible strength.

An annular clearance 12d is formed between an outer periphery 12c of the cylindrical portion 12h of the bottom plate 12 and an inner periphery 10e of the main body case 10 and filled with an adhesive.

This specific construction enables the adhesive to secure the bottom plate 12 to the main body case with a still higher bond strength.”

Maeda further states:

“The adhesive to be used is an acrylic anaerobic adhesive which is curable with ultraviolet rays and heat. This adhesive is suitable from the viewpoint of amenability to assembly, and heat resistance to withstand the heat of reflow soldering.” [emphasis added]

In view of the consistent teaching in Maeda of a strong assembly for a sound-vibration generating device, wherein anaerobic adhesive is used that is “heat resistant to withstand the heat of reflow soldering” and that provides the “highest possible strength”, the Examiner’s contention of reheating or dissolving adhesive from annular clearance 12d to allow the housing to be detached from the bracket is completely contrary to Maeda’s purpose for using the adhesive.

Further, Applicant respectfully reiterates that Maeda clearly shows that the clearance 12d is meant for fixing the bracket to the housing in a non-detachable manner, and that the housing is not detachable from the bracket before being mounted on the circuit board.

In addition to the arguments presented above, Applicant’s previously submitted arguments in the Amendment filed October 28, 2008 are still applicable and incorporated herein by reference.

Consequently, since each and every feature of the present claims is not taught (and is not inherent) in Maeda, as is required by MPEP Chapter 2131 in order to establish anticipation, the rejection of claims 1, 5 9/1 and 9/5, under 35 U.S.C. §102(b), as anticipated by Maeda is improper.

In view of the amendment and arguments set forth above, Applicant respectfully requests the Examiner to consider Maeda in its entirety as set forth in MPEP 2141.02(VI), and Applicant respectfully requests reconsideration and withdrawal of the §102(e) rejection.

3. Rejections under 35 U.S.C. §103(a)

With respect to the rejection of claims 2, 5, 6, 9/2, 9/5, and 9/6 under 35 U.S.C. §103(a) as being unpatentable over Maeda, Applicant respectfully traverses the rejection at least for the reason set forth above in relation to the §102(c) rejection of claim 1 and 9/5.

As discussed previously, due to high temperature of solder reflow process, the multifunctional vibrating actuator of the presently claimed invention is detachable from the bracket so as to allow the bracket to be fixed to the circuit prior to mounting the multifunctional vibrating actuator to the circuit board via the bracket. By such a configuration, the multifunctional vibrating actuator avoids being subjected to stress, misalignment, damages, etc. that may be caused if the multifunctional vibrating actuator was

fixed to the circuit board and subjected to high temperature solder reflow process. Applicant respectfully assert that Maeda is directed to a strong assembly for a sound-vibration generating device with the use of anaerobic adhesive to provide the strongest possible bond that is resistant to heat. Hence, Maeda fails to teach, disclose, or suggest such an issue and how to overcome the problems of subjecting the device to high temperature reflow with a mounting structure. Rather, contrary to Applicant's invention, Maeda relies on strong adhesive that resists damage from high temperature reflow.

The requirements for establishing a *prima facie* case of obviousness, as detailed in MPEP § 2143 - 2143.03 (pages 2100-122 - 2100-136), are: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the teachings; second, there must be a reasonable expectation of success; and, finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

Further, according to MPEP §2141(I), Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

Moreover, according to MPEP §2141(II), when applying 35 U.S.C. §103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined.

As Maeda fails to teach, disclose, or suggest a multifunctional vibrating actuator detachable from a bracket and configured to be mounted on a circuit board using the bracket after the bracket is fixed to the circuit board, the §103(a) rejections are improper.

In view of the amendment and arguments set forth above, Applicant respectfully requests reconsideration and withdrawal of the §103(a) rejection.

8. Conclusion

In view of the amendments to the claims, and in further view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is requested that claims 1-9 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's representative, the Examiner is invited to contact the undersigned at the numbers shown.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-4525.

Respectfully submitted,

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